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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,579	07/12/2001	Martin Grosshart	Q65122	3620
7590	01/14/2005			
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			EXAMINER NGUYEN BA, HOANG VU A	
			ART UNIT 2122	PAPER NUMBER

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,579

Applicant(s)

GROSSHART ET AL.

Examiner

Hoang-Vu A Nguyen-Ba

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment dated September 17, 2004.
2. Claims 1-24 are pending.

Response to Amendment

3. Per Applicants' request, claims 1-11 have been amended and new claims 12-24 have been added.

Response to Arguments

4. Rejection of claims 1-11 under 35 U.S.C. § 101:

Applicant's arguments have been fully considered but they are persuasive. See Examiner's response in ¶ 8.

5. Rejection of claims 1-11 under 35 U.S.C. § 102(b):

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Objection

6. Claims 5 and 6 objected to because of the following informalities: claim 6 is a duplicate of claim 5.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. The invention as disclosed in claims 1-11, 14 and 16-24 are directed to non-statutory subject matter.

The Office's interpretation of these claims is that they do not expressly require performance of any steps by a machine, such as a general-purpose digital computer. Structure will not be read into the claims for the purposes of the statutory subject matter analysis although the steps might be capable of being performed by a general-purpose digital computer.

Statutory subject matter requires two things: 1) it must be in the technological arts; and if it is, 2) it must not fall within the one of the exceptions for "laws of nature, physical phenomena and abstract ideas." Under the most recent Federal Circuit cases, transformation of data by a machine (e.g., a computer) is statutory subject matter provided the claims recite a "practical application, i.e., a useful, concrete and tangible result." *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.* 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998). The claims in this instance, do not expressly require performance by a computer.

There seem to be three possible tests for statutory subject matter of non-machine-implemented process claims: 1) the definition of a "process" under 35 U.S.C. § 101 as requiring a physical transformation of physical subject matter, tangible or intangible, to a different state or thing; 2) the "abstract idea" exception; and/or 3) the test of whether the claim recites a "practical application, i.e., a useful, concrete and tangible result" under *State Street*, which was stated in the context of transformation of data by a machine or a machine-implemented process, adapted somehow for a non-machine-implemented method.

The Office holds that claims 1-11, 14 and 16-24 are directed to non-statutory subject matter under item 3).

The State Street test requires that subject matter be “useful” and “concrete” and “tangible.” While the claimed subject matter may be useful (as asserted by Applicant) because it has some utility to society, this is not enough. The Office holds that claims 1-11, 14 and 16-24 are directed to non-statutory subject matter because they do not recite a “practical application” or produce a “concrete and tangible result” under State Street. Specifically in this instance, “using first information model to generate product-specific information model” may satisfy the requirement of transforming data to a different state or thing, however, “storing the product-specific information model in a database” does not make the instant application produce a “concrete and tangible result” because a database by itself is a computer program per se.

Claim Rejections – 35 U.S.C. § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

10. Claims 1-2 and 7-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0167764 A1 by Wohl et al. (“Wohl”).

Claim 1

Wohl discloses at least a method comprising:

incorporating definitions of a plurality of subcomponents of an overall system to generate a first information model in coded form in a first description language (see at least Figure 3, item 340; Figure 6B, step 610; and related discussion in the specification);

storing the first information model in a first database (see at least Figure 6B, step 622 and related discussion in the specification);

using the first information model to generate one or more product-specific information models by selecting one or more first parameters (see at least Figure 3, item 310; Figure 6B, steps 612-620 and related discussion in the specification); and

storing the one or more product-specific information models in a second database (see at least Figure 6B, step 622 and related discussion in the specification).

Claim 2

The rejection of base claim 1 is incorporated. Wohl further discloses

using the one or more product-specific information models to generate one or more project-specific information models selecting one or more second parameters (see at least Figure 3, item 310; Figure 6B, steps 612-620 and related discussion in the specification); and

storing the one or more project-specific information models in a third database (see at least Figure 6B, step 622 and related discussion in the specification).

Claim 7

Claim 7 recites the same features of claim 1, except that the first information model is being used to generate product profiles or comparison of product profiles instead of being used to generate product-specific information models. Product profiles or comparison of product profiles are indeed product-specific information. Since the information being used is from the same first information model and the generating step being implemented is the same generating step of claim 1, claim 7 is considered to merely recite an obvious variation of claim 1. Therefore, the same rejection is applied.

Claim 8

The rejection of base claim 7 is incorporated. Since claim 8 recites the same features of claims 7 and 2, the same rejections are applied. A fourth database is merely another database with the same structure of the first, second or third database or merely another section among the other sections (e.g., first, second, or third database) of the same main database. The recitation of the modifier “first,” “second,” “third,” “fourth” or “fifth” will not be considered to help distinguish the databases among themselves.

Claim 9

The rejection of base claim 7 is incorporated. Since claim 9 recites the same features of claims 1, 2 and 8, the same rejections are thus applied.

Claim 10

Since claim 10 recites an information-processing system that implements the same method of claim 1, the same rejection is applied.

Claim 11

Since claim 11 recites a software product tangibly embodied on a computer-readable medium that is used to implement the same method of claim 1, the same rejection is applied.

Claim 12

Since claim 12 recites an information-processing system that implements the same method of claim 7, the same rejection is applied.

Claim 13

Since claim 13 recites a software product tangibly embodied on a computer-readable medium that is used to implement the same method of claim 7, the same rejection is applied.

Claims 14, 15, 16, 17 and 18

See rationale discussed in conjunction with the rejection of claim 8.

Claims 19 and 22

Rejections of base claims 1 and 7 are incorporated. Wohl further discloses *signaling a syntactical error when at least one syntactical error exists in the definitions of the subcomponents* (see at least section [0008]).

Claims 20 and 23

Rejections of base claims 1 and 7 are incorporated. Wohl further discloses *identifying an unresolved link when at least one unresolved link exists between the definitions of the subcomponents* (see at least section [0008]).

Claims 21 and 24

Rejections of base claims 1 and 7 are incorporated. Wohl further discloses *recognizing and signaling a contradictory specification among the definitions when the contradictory specification among the definitions of the subcomponents exists* (see at least section [0008]).

Claim Rejections – 35 USC § 103

11. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohl in view of CCITT, Recommendation X.722, Information Technology – Open Systems Interconnection – Structure of Management Information: Guidelines for the Definition of Managed Objects, 1992.

Claim 3

The rejection of base claim 1 is incorporated. Wohl does not specifically disclose *wherein the one or more product-specific information models are coded in a second description language different from the first description language*. However, CCITT provides guidelines for open systems interconnections (see at least section 1) for the purpose of encouraging consistency between models coded in different description language. It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to use CCITT guidelines in Wohl as this would facilitate the exchange of information coded using Wohl model with those coded using another model.

Claim 4

The rejection of base claim 1 is incorporated. Wohl does not specifically disclose *wherein the one or more product-specific information models describe one or more network elements of a communications network*. However, CCITT provides Recommendation X.722 for Data Communication Networks for the purpose of encouraging consistency between models coded in different description language. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use CCITT guidelines in Wohl as this would facilitate the exchange of information coded using Wohl model with those coded using another model.

Claim 5

The rejection of base claim 1 is incorporated. Wohl does not specifically disclose *using the one or more project-specific information models to generate one or more software components for one or more network elements of a communication network*. However, CCITT (see at least sections 8.3, 8.4 and 8.5) provides Recommendation X.722 for Data Communication Networks for the purpose of encouraging consistency between models coded in different description language. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use CCITT guidelines in Wohl as this would facilitate the exchange of information coded using Wohl model with those coded using another model.

Claim 6

The rejection of base claim 1 is incorporated. Since claim 6 is a duplicate of claim 5, the rejection of claim 5 is thus applied.

Conclusion

13. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 6:45 to 16:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANTHONY NGUYEN-BA
PRIMARY EXAMINER

Art Unit 2122

January 9, 2005